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10/803,237	03/18/2004	Beat Heer	A01503	5627
7590		11/29/2007		
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			EXAMINER	
			PRYOR, ALTON NATHANIEL	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/803,237  
Filing Date: March 18, 2004  
Appellant(s): HEER ET AL.

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Kenneth Crimaldi  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 7/18/07 appealing from the Office action  
mailed 3/26/07.

**(1) Real Party in Interest**

A statement identifying by name the real party in interest is contained in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The statement of the status of claims contained in the brief is correct.

**(4) Status of Amendments After Final**

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) Summary of Claimed Subject Matter**

The summary of claimed subject matter contained in the brief is correct.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct. However, the rejection of claims 1,6-8, and 10-12 under 35 USC 112, 1<sup>st</sup> paragraph has been withdrawn.

**(7) Claims Appendix**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(8) Evidence Relied Upon**

JP2001302418

Yamaguchi et al

10-2001

**(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1,6-8,10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yamaguchi et al on record. Yamaguchi teaches a composition comprising 15 parts 2-methyl-4-isothiazoline-3-on (MIT) and 20 parts 2-methyl-1,2-benzisothiazolin-3-one which equates to a ratio of MIT:MBI being 1:1.33 (See Table 1 Example 5). Yamaguchi teaches a combination comprising 99 to 1 parts MIT and 1 to 99 parts MBI, which would fall within the instant ratio of MIT:MBI of 750:1 to 1:1. Yamaguchi teaches that the composition can be used in household products such as paints. See paragraph 1. Yamaguchi does not teach the instant ratio of MIT:MBI being 1:1. However, it would have been obvious to one having ordinary skill in the art to employ the ratio (1:1) claimed by applicant since it is so close to the ratio (1:1.33) taught by Yamaguchi. In the absence of unexpected results, one having ordinary skill in the art would have been motivated to do this because the 1:1.33 for MIT:MBI is extremely close to and rounds off to the claimed ratio of 1:1 for MIT:MBI. One would have expected data collected using both ratios to be similar due to the closeness of the claimed ratio and Yamaguchi's ratio.

Applicants point out that the instant specification discloses synergistic results for a composition comprising a non-halogenated 2-alkyl-4-isothiazolin-3-one (MIT) plus at

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least one of 2,2'-dithiobis(N-methylbenzamide) (DTBMA) and MBI in a ratio ranging from 750:1 to 1:1 on pages 10-21 of the instant specification. The combination of MIT and DTBMA in instant ratio range is unquestionable since Yamaguchi and no other prior art teaches the combination yielding synergistic results. Also, the prior art does not provide an exemplification of the two ingredients in a single composition to anticipate or make obvious the combination. For this reason the composition comprising MIT and DTMBA is allowable. While it is true that the specification provides synergistic result on pages 10-21 of the specification for the combination of MIT:MBI in the ratio range of 750:1 to 1:1, Yamaguchi's discloses a composition comprising MIT:MBI in the ratio of 1:1.33 (see Example 5), which falls outside of the claimed ratio range. Since the ratio of 1:1.33 for MIT:MBI is extremely close to and rounds off to the claimed ratio of 1:1 for MIT:MBI, one would have expected data collected using both ratios to be similar due to the closeness of the claimed ratio and Yamaguchi's ratio.

#### **(10) Response to Argument**

Appellant argues that Yamaguchi does not demonstrate that the combinations disclosed therein are synergistic at any ratio. Appellant argues that Yamaguchi teaches a ratio of 1:1.33 of MIT:MBI (Example 5) whereas the instant claims recite a ratio 750:1 to 1:1. Examiner argues that Yamaguchi teaches a combination comprising 99 to 1 parts MIT and 1 to 99 parts MBI, which would fall within the instant ratio of MIT:MBI of Example argues that Yamaguchi teaches a combination comprising 99 to 1 parts MIT and 1 to 99 parts MBI, which would fall within the instant ratio of MIT:MBI of 750:1 to 1:1.750:1 to 1:1. Appellants argue that they have obtained unexpected synergistic

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interaction between MIT and MBI in the claimed range ratios and that Yamaguchi contains no data illustrating any synergistic interaction at any ratio. Examiner acknowledges applicants' data obtained from the combination of MIT:MBI in a ratio of 1:1. However, Examiner reiterates that Yamaguchi discloses MIT:MBI in a ratio of 1:1.33. It would have been obvious to one having ordinary skill in the art to employ the ratio (1:1) claimed by applicant at the time of Yamaguchi's invention since it is so close to the ratio (1:1.33) taught by Yamaguchi. In the absence of unexpected results, one having ordinary skill in the art would have been motivated to do this because the 1:1.33 for MIT:MBI is extremely close to and rounds off to the claimed ratio of 1:1 for MIT:MBI. One would have expected data collected using both ratios to be similar due to the closeness of the claimed ratio and Yamaguchi's ratio.

**(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



Alton Pryor, Primary Examiner, A.U. 1616

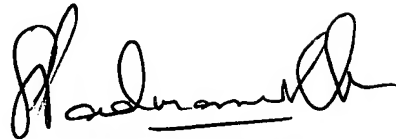
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